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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,265	12/21/2001	Robert Vallee Gaines	122342-1002	6828

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EXAMINER


HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/032,265	Applicant(s) GAINES, ROBERT VALLEE	
	Examiner Calvin L Hewitt II	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3-19-02</u> . | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1-23 have been examined.

Claim Objections

2. Claim 11 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 11 is dedicated to jewelry. Claim 9 from which claim 11 depends recites a computer system. However, the jewelry is outside the system.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 17 and 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 17 is dedicated to a memory for storing non-functional data (e.g. credit card information, medical information, etc.). Therefore, as the claim recites

nonfunctional descriptive material recorded on a computer-readable medium it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Similarly, a claim to a data structure that stores non-functional data is also non-statutory (*In re Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760; *In re Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978)).

Claims 18 is also rejected as it depends from claim 17.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-8 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the authentication result" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claims 2-8 are also rejected as they depend from claim 1.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3-10, 12-20, 22, and 23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Weinstein, U.S. Patent No. 4,453,074.

As per claims 1, 3-10, 12-20, 22, and 23, Weinstein teaches a method for authenticating the identity of a person comprising:

- receiving personal data through an interface of a miniaturized computer (figure 5, items 28, 30 and 32), comparing the personal data to data stored in the computer's memory (figure 6) and displaying the authentication result (figure 5, item 14; column 8, lines 50-56; column 13, lines 24-28 and 47-55)
- receiving personal data such as a digital signature, password, or biometric data (e.g. DNA, retina, fingerprint, face or voice scan) (column 1, lines 27-65)

- processing financial transactions including credit/debit cards, electronic, electronic cash transfers and paper money (column 1, lines 28-43; column 2, lines 12-24)
- storing an identifier code in a processor of the computer (abstract; column/line 9/62-10/13)
- verifying personal data in a remote processing unit linked to a remote device for receiving data from said computer (abstract; figures 6 and 7; column/line 9/62-10/14)
- a mechanical interface for sending and receiving data (figures 4 and 5)
- a remote device with a reader and an interpreter with a second processor for authorizing an action or transaction (abstract; figures 6 and 7)
- a transmitter for sending data to a remote device (abstract; figures 4 and 5)
- maintaining personal, credit card, medical, non-public identification, electronic currency and identifier code in memory (abstract; column 1, lines 28-65; column/line 9/62-10/13)
- maintaining business card and encryption information (abstract; column 1, lines 28-65; column/line 9/62-10/13)

Art Unit: 3621

- a security protocol (e.g. unique ID, password, biometric ID, confirmation from a remote database, remote shutdown, storage of incriminating data) (abstract; figures 6 and 7)

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2, 11 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weinstein, U.S. Patent No. 4,453,074.

As per claim 2, the use of smart cards in voting is old and well-known.

As per claim 11, it would have been obvious to one of ordinary skill to maintain the intelligent card in a storage container (e.g. wallet, purse, box, precious stone laden apparatus) in order to keep it secure.

As per claim 21, non-contact or contact-less smart cards are old and well-known.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Sehr teaches smart cards for voting
- Gressel teaches a biometric security system
- Teicher teaches wireless smart card transactions

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

Art Unit: 3621

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Calvin Lloyd Hewitt II

December 1, 2004

